

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BRUCE PRESTON WILLIAMS, GORDON PLATTO and  
JOHN KYUNGWOOK KIM

Appeal No. 2005-1264  
Application No. 09/682,594

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 35 and 37-39, which are all of the claims pending in this application. Claim 36 was canceled and claims 37 and 38 were amended subsequent to the final rejection in an amendment filed February 17, 2004, approval of the amendment for entry being indicated in the advisory action mailed March 11, 2004.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a re-configurable roof rack system for a vehicle including at least one storage surface having a first position generally coincident with the roof of the vehicle and a second position generally coincident with a side of the vehicle. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

***The Applied Prior Art***

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Aftanas et al. (Aftanas)	6,338,427	Jan. 15, 2002 (filed Mar. 17, 2000)
Parkins (British patent specification)	1,043,227	Sep. 21, 1966

***The Rejections***

The following rejections are before us for review.

Claims 35 and 37-39 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that appellants, at the time the application was filed, had possession of the claimed invention.

Claims 35 and 37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Aftanas.

Claims 35 and 37-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aftanas in view of Parkins.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed October 21, 2003) and answer (mailed June 16, 2004)) for the examiner's complete reasoning in support of the rejections and to the brief (filed April 12, 2004) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, to the declaration of Le Nguyen (the Nguyen declaration), a copy of which was appended to the appeal brief, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn our attention first to the rejection of claims 35 and 37-39 under the first paragraph of 35 U.S.C. § 112. We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to

the description requirement, the court in Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*.

... drawings alone *may* be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

It is also well settled that the question of whether a modification is an obvious variant of that which is originally disclosed is irrelevant insofar as the written description requirement is concerned. See, e.g., Lockwood v. American Airlines Inc., 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) and In re Wohnsiedler, 315 F.2d 934, 937, 137 USPQ 336, 339 (CCPA 1963). See also In re Barker, 559 F.2d at 593, 194 USPQ at 474, wherein the court, in quoting with approval from In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975) set forth: "That a person skilled in the art might realize from reading the disclosure that such a step is **possible** is not a sufficient indication to that person that that step is part of appellants' invention."

With these authorities in mind, we have carefully reviewed the appellants' original disclosure and find no descriptive support therein for "a first connecting member moveably affixed to the first guide rail and ***hingedly*** connected to the storage surface" or "a second connecting member moveably affixed to the second guide rail and ***hingedly*** connected to the collapsible storage surface" as recited in claim 35 (emphasis ours). We also fail to find descriptive support in the appellants' original disclosure for "a side element defining a ***recess*** for receiving a bungee cord" as recited in claim 37 (emphasis ours) or a "collapsible rail ***hingedly*** affixed to the hinge bar" as recited in claim 38 (emphasis ours).

We note, at the outset, that any reliance by the appellants or declarant Le Nguyen on the provisional application from which the present application claims priority is misplaced, as the disclosure of the provisional application is not expressly incorporated by reference into the present application. 37 CFR § 1.57(a) provides that, under certain conditions, a claim for the benefit of a prior-filed provisional application is considered an incorporation by reference of the prior-filed provisional application for certain purposes. See Changes To Support Implementation of The United States Patent and Trademark Office 21<sup>st</sup> Century Strategic Plan, 69 Fed. Reg. 56481, 56539 (Sept. 21, 2004) (final rule). 37 CFR § 1.57(a) became effective on September 21, 2004 and applies only to applications filed on or after September 21, 2004. Id. at 56482, 56500. The instant application was filed on September 25, 2001, before the

effective date of 37 CFR § 1.57(a), and thus may not rely on the incorporation by reference provision of 37 CFR § 1.57(a). Rather, the instant application is subject to the rule of decision that the mere reference to another application is not an incorporation by reference of such application. Cf. In re Lund, 376 F.2d 982, 989, 153 USPQ 625, 631-32 (CCPA 1967) (A single sentence in a specification of a later-filed application identifying that application as a continuation-in-part of an earlier application would not suggest to the reader that the disclosure of the earlier application should be considered part of the later-filed application so as to constitute a tacit description of the subject matter in the earlier application).

With respect to claim 35, the disclosed structure in the appellants' original disclosure corresponding to the recited first and second guide rails must be guide elements 38, one of which is identified in Figures 1 and 3. The only structures disclosed in the appellants' original application as moveably affixed in any fashion to the guide elements 38 are track elements 36, "which travel along guide elements 38" (specification, page 5). It thus follows that the "first connecting member" and "second connecting member" recited in claim 35 must correspond to track elements 36 which, together with the plurality of slat elements 34 mounted between track elements 36, make up the left or right storage surface 30 or 32. Accordingly, it would have been apparent to one of ordinary skill in the art from the appellants' original disclosure that the track elements (recited as "track members" in claim 35), themselves part of the

to the track elements 36 so as to provide support for connecting members moveably affixed to the guide rails and hingedly connected to the storage surface.

The discussion in the appellants' brief with regard to the pivotal arrangement of the side rails 26 for movement between the raised position (Figure 1) and outwardly lowered and collapsed positions (Figure 2) bears absolutely no relevance to the issue of whether the appellants' original disclosure provides descriptive support for the connecting members being hingedly connected to the storage surface.

For the foregoing reasons, the examiner's rejection of claim 35 and claims 37-39, which depend from claim 35, under the first paragraph of 35 U.S.C. § 112, as containing subject matter which was not supported in the appellants' application as originally filed, is sustained. Moreover, for the reasons which follow, the examiner's additional bases for rejecting claims 37-39 as lacking descriptive support are also well founded.

With particular regard to claim 37, the appellants' application as originally filed discloses latching areas 52, which "may be utilized as a convenient location to attach bunge [sic] cords or other securing straps" (specification, page 5). The specification,

however, is silent with regard to the latching areas 52 being “recesses” as called for in claim 37. The appellants attempt to rely on the original drawings filed with the present application as purportedly reflecting that the latching areas 52 are recesses. The latching areas are illustrated in each of the original drawing Figures 1-4. There is nothing in Figures 1 and 4 which indicates either protruding or recessed contour to the latching areas 52. While the detail of the latching area 52 illustrated in Figures 2 and 3 could indicate a recess, it could also indicate a pivoted link or eyelet structure about which the hook structure of a bungee cord could be engaged. The statement in paragraph 16 of the Nguyen declaration that “the drawings clearly show that the mounting members are provided with identified recesses” is simply not commensurate with the scope of the original disclosure. Specifically, while latching areas 52 for attachment of a bungee cord are clearly identified, they are not identified as recesses.

Finally, with regard to claim 38, we do not understand the additional basis of the examiner’s rejection of this claim under the first paragraph of 35 U.S.C. § 112 to be that the appellants’ application as originally filed failed to provide support for a “hinge bar” affixed between the first track element and the second track element, as appellants’ argument (brief, page 13) implies. Rather, the examiner’s position is that the appellants’ original disclosure failed to provide descriptive support for a collapsible rail “hingedly affixed to the hinge bar” as further recited in claim 38. For the following reasons, the examiner’s position in this regard is well taken.

There can be no reasonable dispute that the appellants' original specification and drawings would have conveyed to one of ordinary skill in the art that the collapsible rail 26 is pivotable between a raised position, as seen in Figure 1, and a collapsed position, as illustrated in Figure 2 (the front section) and in Figures 3 and 4. While the second full paragraph on page 5 of the original specification certainly confuses the issue as to whether the end rail elements 42, 44 correspond to the collapsible rails 26, in any event, it is abundantly clear from the original disclosure that the end rail elements 42, 44 also pivot between a raised position forming a basket 46 on the roof of the vehicle and a collapsed portion and further can serve as a base support for objects mounted on the side portion of the vehicle when the storage surface is moved to the second position. Moreover, there appears to be a slat disposed along the pivot axis of the collapsible rail segment. To the extent that such slat is located at the pivot axis, reference to such slat as a "hinge bar" may not be objectionable or raise the issue of new matter. One of ordinary skill in the art would have understood that the pivoting action of the end rail elements or collapsible rails relative to the storage surface (or track elements 36) could be accomplished either by pivoting the other two lateral slats and connecting elements of the end rail element or collapsible rail together with the slat located at the pivot axis (the "hinge bar") relative to track elements 36 or by pivoting the other two lateral slats and connecting elements of the end rail element or collapsible rail relative to the slat located at the pivot axis (the "hinge bar"). In light of the absence

of the illustration or other disclosure of any hinge structure between the "hinge bar" and the remainder of the end rail elements or collapsible rail structure, the original disclosure would most probably have conveyed the former arrangement. In any event, the present application, as originally filed, provided no hint or indication that the collapsible rail is "hingedly" affixed to a hinge bar affixed between the track elements. As discussed above, that one of ordinary skill in the art might realize that the now-recited feature of the claim is possible is not sufficient to provide written descriptive support for the invention as required by the first paragraph of 35 U.S.C. § 112. See Winkhaus, 527 F.2d at 640, 188 USPQ at 131.

The appellants (brief, page 17) and the examiner (answer, pages 3-5) both address the examiner's objection to amendments to the specification and drawings as containing new matter. Normally, objections are addressable by petition under 37 CFR § 1.181 and are not reviewed by the Board except where they are relevant to an appealed rejection. Accordingly, we will not individually address the examiner's objections in this decision except to point out that, to the extent that any of the examiner's objections are inconsistent with our decision with regard to the rejection under 35 U.S.C. § 112, first paragraph, they are improper and should be withdrawn.

We turn our attention next to the rejection of claims 35 and 37 as being anticipated by Aftanas. As aptly noted by the appellants in their brief, the article carrier of Aftanas is movable between a first position wherein the storage surface is parallel to

(generally coincident with) a roof of the vehicle (Figure 18) and a second position wherein the storage surface is generally coincident with the rear side of the vehicle (Figure 19). There is no position of the carrier wherein the storage surface is generally coincident with a lateral side of the vehicle as called for in claim 35.

The examiner's position that claim 35 is directed to the roof rack only and that the recitation of the vehicle and its relation to the roof rack is merely functional language (answer, page 5) is not well taken. It is true that the preamble of claim 35 recites only a "re-configurable vehicle roof rack system," but claim 35 also positively recites "a first guide rail and a second guide rail **affixed** to the vehicle roof." This limitation necessarily requires the guide rails of the system to be affixed to the vehicle roof, which likewise constitutes a positive recitation of the vehicle in combination with the storage surface, guide rails and connecting members of the roof rack system. Accordingly, the limitation that the connecting members slide along the guide rails to move the storage surface between a first position generally coincident with the roof of the vehicle and a second position generally coincident with a lateral side of the vehicle cannot simply be dismissed as functional or intended use language. As noted above, this limitation is not met by Aftanas. Accordingly, the anticipation rejection of claim 35, and claim 37 which depends therefrom, cannot be sustained.

The examiner's application of the teachings of Parkins provides no cure for the deficiency of Aftanas discussed above. It therefore follows that the rejection of claims 35 and 37-39 as being unpatentable over Aftanas in view of Parkins also cannot be sustained.

CONCLUSION

To summarize, the rejection of claims 35 and 37-39 under 35 U.S.C. § 112, first paragraph, is sustained and the rejections of claims 35 and 37 under 35 U.S.C. § 102(e) and claims 35 and 37-39 under 35 U.S.C. § 103 are reversed. As a rejection of each of the claims on appeal has been sustained, the examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

  
JOHN P. MCQUADE  
Administrative Patent Judge

JOHN P. MCQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

**JEFFREY V. NAGE  
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